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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,941	11/10/2005	Gerard Bradley	1022702-000282	8313
21839	7590	10/03/2008		
BUCHANAN, INGERSOLL & ROONEY PC			EXAMINER	
POST OFFICE BOX 1404			THOMAS, JAISON P	
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			1796	
NOTIFICATION DATE	DELIVERY MODE			
10/03/2008	ELECTRONIC			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/536,941	<b>Applicant(s)</b> BRADLEY ET AL.
	<b>Examiner</b> Jaison P. Thomas	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 23 June 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 15-23,27 and 28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 15-23,27 and 28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/96/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to amendments filed on 6/23/2008.
2. Claims 15-23, 27 and 28 are pending. Claims 1-14 and 24-26 are cancelled.

Claims 27 and 28 are new.

3. Claims 15-23 stand rejected under 35 USC 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Bastiaens et al. (US Patent 7022776).
4. Claims 15-23 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over Hagimori et al. (EP 0535955).

***Response to Arguments***

5. Applicant's arguments filed 6/23/2008 have been fully considered but they are not persuasive.

Applicants contend that the Bastiaens and Hagimori references both teach composition wherein the carbon black is intimately mixed with polyamide matrix and impact modifier, but does not teach a composition where the filler is dispersed in the impact modifier phase. The Applicant's further contend, with respect to Bastiaens, that it would not be obvious to one of ordinary skill to incorporate the conductive filler in the dispersed phase since the conductivity of the polyamide composition would be lowered.

The Examiner respectfully disagrees with Applicants. Considering Claim 1, the Examiner notes that claims merely require that the dispersed phase of impact modifier contain some amount of carbon black suitable for electrostatic painting. Absent an art-

recognized definition of what level of loading is required, the Examiner construes that a minor amount of carbon black could meet the said level. As notoriously well known in the art of producing polymer composites, when compounding matrix polymers with fillers it is possible that the carbon black will be dispersed between both the polyamide matrix and the impact modifier dispersed phase. As far as the explicit requirements of Claim 1 are concerned, the Examiner finds that the Bastiaens and Hagimori references would inherently, or be reasonably expected by one of ordinary skill in the art, to have impact modifier which has carbon black associated with therein as a byproduct of the compounding process.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 15-23, 27 and 28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyoshi et al. (US Patent Application Pub. No. 2003/0134963).

Miyoshi et al. teaches a conductive resin composition wherein the composition is comprised of polyamide, polyphenylene ether, an impact modifier and conductive filler where in the filler is preliminarily compounded with the impact modifier and polyphenylene ether. The composition is suitable for use in electrostatic coating applications (Abstract). The references teaches that not less than 50-70% of the total conductive filler is preliminarily compounded with the impact modifier and polyphenylene ether (pg. 7, para. 0120). Various types of impact modifiers, described as copolymers, are disclosed on pg. 5, paras. 0076-0082 which includes low molecular weight block copolymers that the Examiner construes as an elastomer. Weight parts of the various components in the compositions are shown on Table 3, pg. 12. Various types of polyamides are disclosed on pg.2, para. 0035 and various types of conductive filler are disclose on pg. 6, para. 0108.

In the alternative, the reference does not teach the required conductive filler levels in the dispersed phase as required by Claims 27 and 28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the loading levels of carbon black of Miyoshi et al. through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of

unexpected results which properly rebuts the prima facie case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Miyoshi suggests through the various levels of loading in the masterbatch that the amount of conductive filler is optimizable result effective variable.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaison P. Thomas whose telephone number is (571) 272-8917. The examiner can normally be reached on Mon-Fri 9:30 am to 6:00 pm.
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. P. T./  
Examiner, Art Unit 1796

/DOUGLAS MC GINTY/  
Primary Examiner, Art Unit 1796